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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,573	03/22/2001	Hector F. DeLuca	1256-00721	9707

7590 02/12/2002

Thomas M. Wozny  
ANDRUS, SCEALES, STARKE & SAWALL, LLP  
Suite 1100  
100 East Wisconsin Avenue  
Milwaukee, WI 53202-4178

EXAMINER

JIANG, SHAOJIA A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/815,573	DELUCA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Shaojia A. Jiang	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 December 2001.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on December 7, 2001 in Paper No. 6 wherein claim 1 has been amended. Currently, claims 1-7 are pending in this application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by DeLuca et al. (4,338,312) for reasons of record stated in the Office Action July 17, 2001.

Applicant's amendment adding "lactating" to a dairy cow in claim 1 and remarks filed on December 7, 2001 in Paper No. 6 with respect to the rejection of claims 1 and 4-6 made under 35 U.S.C. 102(b) as being anticipated by DeLuca et al. (4,338,312) have been fully considered but are not deemed persuasive to remove the rejection for the following reasons.

Applicant asserts that the DeLuca '312 patent discusses the feeding of a high calcium and low phosphorus diet to Holstein cows "in the dry period". However, DeLuca clearly discloses the method for prophylactically treating dairy cow for parturient paresis comprising administering the instant compounds (see claims 1 and 3). Parturient paresis (milk fever) is known to be a metabolic disease of dairy cows including lactating

Art Unit: 1617

dairy cows resulting from parturition and the initial formation of milk according to DeLuca (col.1 lines 8-15). Thus, the scope of DeLuca's method nowhere is limited to dairy cows "in the dry period". The Example (at col.3) in which the third lactation or better Holstein cows were fed in the dry period is merely a particular example of the method therein.

Applicant asserts that the "low phosphorus" in the Example (col.3) contains approximately 0.5% phosphorus. However, DeLuca nowhere teaches that "low phosphorus contains approximately 0.5% phosphorus. Moreover, the instant claim 1 is limited to "feeding a feed that contains about 0.3% by weight or less of an inorganic phosphorus supplement". Thus, the claim may be read as 0.3% to 0% of an inorganic phosphorus supplement employed herein. Thus, DeLuca's method comprising administering the instant vitamin D compounds is seen clearly inherent in a method of maintaining milk production in a dairy cow herein.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 102(b) as being anticipated by DeLuca et al. (4,338,312).

Claims 1, 4-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by DeLuca et al. (4,110,446) for reasons of record stated in the Office Action July 17, 2001.

Applicant's amendment adding "lactating" to a dairy cow in claim 1 and remarks filed on December 7, 2001 in Paper No. 6 with respect to the rejection of claims 1, 4-5, and 7 made under 35 U.S.C. 102(b) as being anticipated by DeLuca et al. (4,110,446) have been fully considered but are not deemed persuasive to remove the rejection for

the same reasons as discussed above in the 102(b) rejection anticipated by DeLuca et al. (4,338,312). Additionally, DeLuca clearly discloses that the method therein is employed in lactating dairy cows (see col.3-4 Table 2-3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLuca et al. (4,338,312 and 4,110,446) for reasons of record stated in the Office Action July 17, 2001.

Applicant's amendment adding "lactating" to a dairy cow in claim 1 and remarks filed on December 7, 2001 in Paper No. 6 with respect to this rejection have been fully considered but are not deemed persuasive to remove the rejection for the same reasons as discussed above in the 102(b) rejection anticipated by DeLuca et al. (4,338,312).

Applicant's results on testing the instant vitamin D compounds in the specification at pages 13-17 have been fully considered with respect to the nonobviousness and/or unexpected results of the claimed invention but are not deemed persuasive. The results

of Tables 2-4 at pages 15-17 showing the effects of the instant vitamin D compounds are clearly expected for the instant claimed method based on the cited prior art. Therefore, the results herein are clearly expected and not unexpected based on the cited prior art. Expected beneficial results are evidence of obviousness. See MPEP § 716.02(c). Results herein provide no clear and convincing evidence of nonobviousness or unexpected results over the cited prior art. Therefore, the evidence presented in specification herein is not seen to support the nonobviousness of the instant claimed invention over the prior art.

In view of the rejections to the pending claims set forth above, no claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

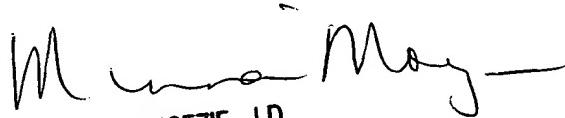
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, J.D., can be reached on (703) 308-4612. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.  
Patent Examiner, AU 1617  
January 30, 2002



MINNA MOEZIE, J.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600